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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/772,460	01/30/2001	Timothy Alexander Gordon	14244	7156
7590 04/07/2005 Scully, Scott, Murphy & Presser 400 Garden City Plaza Garden City, NY 11530			EXAMINER TRAN, ELLEN C	
			ART UNIT 2134	PAPER NUMBER

DATE MAILED: 04/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/772,460

**Applicant(s)**

GORDON ET AL.

**Examiner**

Ellen C Tran

**Art Unit**

2134

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***DETAILED ACTION***

1. This action is responsive to communication: filed on 8 November 2004 with an original application filed 30 January 2001, and with acknowledgement of foreign application date of 26 September 2000.
2. Applicant's amendment to the specification, title, and claims are accepted.
3. Claims 1-10 and 12-15, and 17-22 are currently pending in this application. Claims 1 and 12 are independent claims. Claims 1, 3, 4, 12, 14, 15, 17, 18, and 19 have been amended. Claims 11 and 16 have been cancelled. Claims 21 and 22 have been added.

***Response to Arguments***

4. Applicant's arguments filed 8 November 2004 have been fully considered but they are not persuasive.

In response to applicant's argument on page 12, "Alcorn et al. is not directed in any respect to securing a downloading (electronic transfer) of electronic information from a host to a client and, instead, pertains to subject matter unrelated to applicant's invention". The Office disagrees, the reference clearly shows that it is directed to securely transferring subject matter, see '522 col. 2, lines 47-65 and col. 7, lines 15-46 "According to a first aspect of the invention, authentication of a casino game data set is carried out within the casino game console using an authentication program ... The authentication program stored in the unalterable ROM performs an authentication check on the casino game data set at appropriate times, such as prior to commencement of game play, at periodic intervals or upon demand" and "This latter alternate arrangement is indicated by the inclusion of a network subsystem 21 of appropriate configuration

and functional characteristics, which may have Ethernet, RS232 serial, or other network compatibility”.

In response to applicant’s argument on page 14, “By contrast to Alcorn et al’s foregoing method of data authentication, the applicant provides a method securing data transfer and the timing, purpose and character of this method are all very different an unrelated ... The applicant’s data transfer method is for the purpose of securing data so that it is secure and that security is maintained for a transfer of the data to a client”. The Office disagrees the reference has multiple purposes for authentication, however one purpose of the authentication is for effective data transfer see ‘522 col. 3, lines 37-43 “Each time a casino game data set is transferred from the mass storage device to the main memory of the system, the authentication routine is run”.

In response to applicant’s argument on page 15, “In applicant’s system and method, each and every byte/bit of electronic information (data) that is transferred from a host to a client is secured by encryption of the entirety of that information (data), whereas Alcorn et al do not secure any data at all. Rather, they simply use the data to calculate a separate short (several bits only) electronic signature and no change is made to the data itself”. The Office disagrees the applicant is reading limitations from the specification into the claims. The independent claims do not indicate that every byte/bit of electronic data transferred is encrypted.

In response to applicant’s second argument on page 15, “Applicant’s system and method secure the data by means encrypting it using two encryption keys before it is transferred, one key being held by the terminal (client) but the other, non-resident key being maintained separate from the terminal and separately provided to the terminal apart from the encrypted information

.... Alcorn et al. disclose subject matter unrelated to applicant's method and system". The Office disagrees, the reference clearly shows the ability to use two keys for encryption with one key being held apart from the terminal and later supplied see '522 col. 3, line 1 through col. 4, line 13 "style game which consist of two phases: a game data set preparation phase and a game data set checking phase ... providing a data set for a casino game, computing a first abbreviated bit string unique to the casino game data set, encrypting the first abbreviated bit string to provide an encrypted signature of the casino game data set, and storing the casino game data set and the signature in a mass storage device" {Note that the "first key" has the same meaning as the encrypted signature}. The casino game data set checking phase proceeds by computing a second abbreviated bit string from the stored casino game data set using the same hash function, decrypting the stored encrypted signature to recover the first abbreviated bit string and comparing the first and second abbreviated bit strings to determine whether the two strings match ... The encryption/decryption process is preferably performed using a private key/public key technique .... The first storing means preferably comprises a mass storage device, such as a disk drive unit, a CD-ROM unit or a network storage unit".

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language

6. **Claims 1-10 and 12-15, and 17-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Alcorn et al. U.S. Patent No. 6,149,522 (hereinafter '522).**

**As to independent claim 12, "A method for securely downloading encrypted electronic information from a host device to a gaming terminal, said encrypted electronic information being encrypted by at least two security keys, at least a first key of said security keys being resident in said terminal and at least a second key of said security keys being non-resident in said terminal and separately delivered to said terminal apart from said encrypted electron information, said downloading method comprising: (a) transmitting said encrypted electronic information from said host device; (b) receiving said encrypted information at said terminal; and, (c) separately delivering said second non-resident security key to said terminal" is taught in '522 col. 11, lines 3-67 and col. 13, lines 55-67.**

**As to dependent claim 13, "whereby said encrypted electronic information is in the form of packs, said packs comprising a full set of files for updating said terminal's software" is shown in '522 col. 11, lines 54-65.**

**As to dependent claim 14, "whereby delivering comprises providing an electronic security key to said terminal" is disclosed in '522 col. 12, lines 6-32.**

**As to dependent claim 15, "whereby said encrypted electronic information comprises at least one next version security key, whereby said first resident key is replaced by said next version key and used by said decryption component in decrypting a next**

**encryption version of electronic information to be received later by said receiving component”** is taught in ‘522 col. 5, lines 15-27.

**As to dependent claim 17, “further comprising providing in said electronic security key means for decrypting an encrypted master reset component in said terminal”** is disclosed in ‘522 col. 11, lines 24-41.

**As to dependent claim 18, “further comprising providing in said electronic security key information usable by said terminal to distinguish the electronic information version that different electronic keys are configured for”** is taught in ‘522 col. 5, lines 15-22.

**As to dependent claim 19, “whereby said delivering is performed by means of a secure network”** is shown in ‘522 col. 2, lines 47-65.

**As to dependent claim 20, “whereby said network is a wide area Ethernet network”** is disclosed in ‘522 col. 7, lines 15-46.

**As to dependent claim 22, “whereby said encrypted electronic information comprises assigned bit information associated with at least one next version security key, said bit information being for later use with said delivery means to provide a replacement first resident security key for use by said decryption component in decrypting a next encryption version of electronic information”** is taught in ‘522 col. 11, lines 48-56.

**As to independent claim 1,** this claim is directed to the system of the method of claim 12 and is rejected along similar rationale.

**As to dependent claims 2-4, 6-9, and 21** these claims incorporate substantially similar subject matter as claims 13-15, 17-20, and 22; therefore they are rejected along the same rationale.

**As to dependent claim 5, “wherein said cable is wired to provide crossed control lines and bidirectional communications for data transfer”** is taught in ‘522 col. 7, lines 15-46.

**As to dependent claims 10, “wherein said files are stored in said terminal in nonvolatile memory following decryption of said packs”** is shown in ‘522 col. 11, lines 29-42.

### **Conclusion**

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.




7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ellen C Tran whose telephone number is (571) 272-3842. The examiner can normally be reached from 6:30 am to 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory A Morse can be reached on (571) 272-3838. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ellen Tran  
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31 March 2005

  
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